

## REMARKS

After entry of this amendment, claims 1, 3-9, and 26-37 will be pending for the Examiner's review and consideration. Claims 1, 6, 8, and 9 have been amended. No new matter has been added. Claims 10-25 have been withdrawn as subjected to a non-elected species. Reconsideration and allowance of the present application in view of the above amendments and the following remarks is respectfully requested.

This amendment responds to the office action mailed April 29, 2004. In the office action the Examiner:

- rejected claims 1, 3-9, and 26-37 under 35 U.S.C. § 102(b) as being anticipated by European Patent No. 0 834 281 to Larsen ("Larsen").

### Independent Claim 1

Independent claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Larsen. Independent claim 1, as amended, recites, *inter alia*, a device for attaching a fixation element to bone, comprising a longitudinal member and a shaft positioned coaxially within and extending along at least a portion of the longitudinal member, wherein the longitudinal member includes a first cylindrical member and a second cylindrical member attached coaxially to the first cylindrical member, the first cylindrical member being movable telescopically with respect to the second cylindrical member; and wherein the longitudinal member is moveable with respect to the shaft to drive the fixation element into bone. It is respectfully submitted that there is absolutely no disclosure, teaching, or suggestion in Larsen of providing a first cylindrical member and a second cylindrical member, wherein the first cylindrical member is movable telescopically with respect to the second cylindrical member. In contrast, Larsen discloses an elongated tube 250, a cam cap 230, and a pinch block 270. The cam cap 230 includes a rectangular distal portion 231 having an internal bore 232 for receiving the tube 250 and a proximal portion 233 sized and configured to mount a spring 240. The pinch block 270 includes a pair of legs 272 having a jaw 274 for receiving the cam cap 230. Thus, it is respectfully submitted that Larsen does not disclose, teach, or suggest all of the limitations of independent claim 1. Therefore, it is respectfully submitted that independent claim 1 is allowable over the cited prior art. Withdrawal of this rejection and allowance of independent claim 1 is respectfully requested.

Claims 3-7 and 37 all ultimately depend from independent claim 1, and thus, it is respectfully submitted that these claims are equally allowable. Withdrawal of these rejections and allowance of claims 3-7 and 37 is therefore respectfully requested.

#### **Independent Claim 8**

Independent claim 8 was rejected under 35 U.S.C. § 102(b) as being anticipated by Larsen. Independent claim 8, as amended, recites, *inter alia*, a device for attaching a fixation element to bone, comprising a handle member having a recess extending therein, a longitudinal member and a shaft; wherein the longitudinal member includes a first member and a second member attached coaxially to the first member, the first member being movable with respect to the second member and wherein at least a portion of the first member and at least a portion of the second member extends externally of the recess. It is respectfully submitted that there is absolutely no disclosure, teaching, or suggestion in Larsen of providing a longitudinal member comprising a first member and a second member, wherein at least a portion of the first member and at least a portion of the second member extends externally of the recess. In contrast, Larsen discloses a handle 210, a cam cap 230, a pinch block 270, a sheath tube 250, and a plunger rod 260. The handle having an internal chamber 213 and a nose portion 239 with a longitudinal aperture 222. The cam cap 230 and pinch block 270 being fully located within the internal chamber 213 while the sheath tube 250 and plunger rod 260 extend through the aperture 222 formed in the nose portion 239. Thus, it is respectfully submitted that Larsen does not disclose, teach, or suggest all of the limitations of independent claim 8. Therefore, it is respectfully submitted that independent claim 8 is allowable over the cited prior art. Withdrawal of this rejection and allowance of independent claim 8 is respectfully requested.

Claims 26-30 all ultimately depend from independent claim 8, and thus, it is respectfully submitted that these claims are equally allowable. Withdrawal of these rejections and allowance of claims 26-30 is therefore respectfully requested.

#### **Independent Claim 9**

Independent claim 9 was rejected under 35 U.S.C. § 102(b) as being anticipated by Larsen. Independent claim 9, as amended, recites, *inter alia*, a device for attaching a bone tack having a head portion and an insertion end to bone, comprising an elongated outer sleeve having a longitudinal axis, a proximal end, a distal end, and a hollow portion extending along

the longitudinal axis between the proximal end and the distal end, the elongated outer sleeve adapted to contact the head portion of the tack; and a shaft at least a portion of which extends within the channel. It is respectfully submitted that there is absolutely no disclosure, teaching, or suggestion in Larsen of an elongated outer sleeve adapted to contact the head portion of a tack. Rather, as shown in Figs. 6-8, and as stated in the specification, Larsen discloses a plunger rod 260 (*i.e.*, an internal shaft) having a distal end portion 261 which includes "openings 267 to releasably engage the proximal end portion of the legs 15 of the suture anchor 10" and an outer sheath tube 250 having an axial bore 254 for receiving the plunger rod 260. Therefore, it is respectfully submitted, that there is absolutely no disclosure, teaching, or suggestion in Larsen of an elongated outer sleeve adapted to contact the head portion of a tack. In fact, Larsen discloses the exact opposite, Larsen discloses engaging the suture anchor with the internal plunger rod 260.

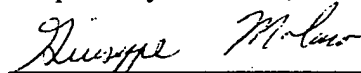
Therefore, it is respectfully submitted that Larsen does not disclose, teach, and/or suggest all of the limitations of independent claim 9. Thus, it is respectfully submitted that independent claim 9 is allowable over the cited prior art. Withdrawal of these rejections and allowance of independent claim 9 is respectfully requested.

Claims 31-36 all ultimately depend from independent claim 9, and thus, it is respectfully submitted that these claims are equally allowable. Withdrawal of this rejection and allowance of claims 31-36 is therefore respectfully requested.

In light of the above amendments and remarks, it is respectfully submitted that claims 1, 3-9, and 26-37 are now in condition for allowance, and the Examiner is respectfully requested to reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at 212-326-7883, if a telephone call could help resolve any remaining issues.

Date: June 29, 2004

Respectfully submitted,



By: Giuseppe Molaro

52,039

(Reg. No.)

35,340

For: Brian M. Rothery

(Reg. No.)

**JONES DAY**

222 East 41st Street

New York, New York 10017

(212) 326-3939